

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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***Ex parte*** CLIFTON W. WOOD JR. and JOHN R. TUTTLE

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Appeal No. 1999-0526  
Application No. 08/581,937<sup>1</sup>

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ON BRIEF

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Before THOMAS, HAIRSTON, and DIXON, **Administrative Patent Judges**.  
DIXON, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1-11, which are all of the claims pending in this application.

We REVERSE.

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<sup>1</sup>Application for patent filed January 2, 1996. According to appellants, this application is a continuation and/or continuation-in-part of many previous applications, the specifics of which are not deemed necessary for a determination of any issues in this case. Accordingly, these prior applications are not listed herein.

## BACKGROUND

The appellants' invention relates to an itinerary monitoring system which logs position and time data for a complete itinerary and transmits the data at the completion of the itinerary. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. An itinerary monitoring apparatus attached to a mobile object, comprising:

a satellite navigation receiver for computing the current geographic position of the mobile object;

a memory;

a controller for storing in the memory a plurality of successive itinerary data points at intervals throughout the itinerary of the mobile object, wherein each successive itinerary data point includes a successive position computed by the navigation receiver and a time of day corresponding to that position; and

a radio transceiver for receiving and transmitting messages by radio communication, wherein the transceiver transmits an itinerary data message containing a number of the itinerary data points stored in the memory.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Aspell et al. (Aspell)	4,908,629	Mar. 13, 1990
Landt et al. (Landt)	5,030,807	Jul. 09, 1991
Mansell et al. (Mansell)	5,223,844	Jun. 29, 1993

Claims 1, 2, 5, 6 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mansell. Claims 3 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mansell in view of Landt. Claims 4, 8, 10 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mansell in view of Aspell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants' regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Sep. 15, 1998) for the examiner's reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed Aug. 10, 1998) and reply brief (Paper No. 16, filed Nov. 23, 1998) for the appellants' arguments thereagainst.

### **OPINION**

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

As pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). We find that the examiner has not provided a teaching or convincing line of reasoning why one skilled in the art would have desired to perform the step of "storing in the memory a plurality of successive itinerary data points at

intervals throughout the itinerary of the mobile object, wherein each successive itinerary data point includes a successive position computed by the navigation receiver and a time of day corresponding to that position” as set forth in the language of claim 1.

“To reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness. **See In re Deuel**, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995). In the absence of a proper *prima facie* case of obviousness, an applicant who complies with the other statutory requirements is entitled to a patent. **See In re Oetiker**, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.” **In re Rouffet**, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). Here, we find that appellants have overcome the *prima facie* case of obviousness by showing insufficient evidence by the examiner of obviousness. Therefore, we will not sustain the rejection of claim 1 nor its dependent claims 2-4.

Throughout appellants’ briefs appellants argue that the prior art does not teach or suggest the language of claim 1 with respect to “storing in the memory a plurality of successive itinerary data points at intervals throughout the itinerary of the mobile object, wherein each successive itinerary data point includes a successive position computed by

the navigation receiver and a time of day corresponding to that position," and that the examiner has not provided a convincing line of reasoning to modify the prior art to store a history of the vehicle's position over time. (See brief at pages 3-5 and reply brief at pages 1-4.)

Appellants argue that Mansell teaches and suggests the storage of data for limited periods while the system is out of range and transmission of position data upon return to the transmission area, but that the storage is based upon an event such as the vehicle being stolen. (See brief at page 4 and Mansell at columns 14 and 15.) We agree with appellants that Mansell does not store a complete history of the itinerary and transmission of the stored data upon interrogation. Furthermore, appellants argue that Mansell is an event driven system rather than a storing of an itinerary (an account or a record of a journey) as set forth in the language of claim 1. The teachings of Mansell would only provide monitoring of those portions of a journey where events occurred. If no events occurred, then no recordation thereof would transpire.

Moreover, the examiner has not provided a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to store in the memory "a plurality of successive itinerary data points at intervals throughout the itinerary of the mobile object, wherein each successive itinerary data point includes a successive position computed by the navigation receiver and a time of day corresponding

to that position.” The examiner maintains that storing the plurality of location data of the vehicle would improve the vehicle tracking and security of the system by having all the information at hand when needed. (See answer at pages 4-5.) While we agree with this conclusion of the examiner, the examiner has not provided a line of reasoning for motivating the skilled artisan to retain this information. Clearly, Mansell does not teach or suggest “storing in the memory a plurality of successive itinerary data points at intervals throughout the itinerary of the mobile object” as set forth in the language of claim 1. (Emphasis added.) Therefore, we will not sustain the rejection of claim 1. Independent claims 5 and 9 contain similar language; therefore, we will not sustain the rejection of claims 5 and 9 and dependent claims 2 and 6.

The examiner has not identified any teaching in Landt or Aspell which would remedy the deficiency in Mansell. Therefore, we will not sustain the rejection of dependent claims 3, 4, 7, 8, 10 and 11.

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### **CONCLUSION**

To summarize, the decision of the examiner to reject claims 1-11 under  
35 U.S.C. § 103 is REVERSED.

JAMES D. THOMAS  
Administrative Patent Judge

KENNETH W. HAIRSTON  
Administrative Patent Judge

JOSEPH L. DIXON  
Administrative Patent Judge

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APPEAL NO. 1999-0526 - JUDGE DIXON  
APPLICATION NO. 08/581,937

APJ DIXON

APJ HAIRSTON

APJ THOMAS

DECISION: **Reversed**

Prepared By: Reginald Kimbrough

**DRAFT TYPED:** 19 Dec 00

**FINAL TYPED:**